REMARKS

Status of Claims

Claims 12-27 are now pending in this application, with claims 12, 13, 24, 26, and 27 being independent. Claims 13, 24 and 27 have been amended to correct minor errors without the introduction of any new matter.

Priority Under 35 U.S.C. § 119

Applicants thank the Examiner for again acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Drawings

Applicants again thank the Examiner for indicating that the drawings filed on October 13, 2005, are accepted.

Failure to Cite Reference on PTO-892

The below noted newly relied upon reference U.S. Patent No. 6,336,124 to Alam should be cited on a PTO-892. See MPEP § 707.05(e).

Rejection Under 35 U.S.C. § 102

Item 2 on page 2 of the outstanding Action presents a rejection of claims 12-27 under 35 U.S.C. § 102(b) as being anticipated by the above-noted reference to Alam (U.S. Patent No. 6,336,124, hereinafter "Alam '124"). This rejection is traversed.

The present invention is characterized by an image processing apparatus which stores information related to a file format which shows whether addition of an image processing command to a converted image data is permitted (prohibited) in a storage unit, determines the file format of a converted designation of a read image data, judges whether the file format thus determined has information which addition of an image processing command to a converted image data is permitted (prohibited) in said storage unit, and when having the information,

addition of the converted image processing command to the converted image data is permitted (prohibited).

On the other hand, Alam '124 discloses a method of converting a document in an input format to a document in a different output format and describes that converting a format such as above is performed via an intermediate format. While both Alam '124 and the present invention are both in the same general technical field of converting formats, the particulars associated with these format conversions are completely different.

In this last respect, the outstanding Action is in error in alleging that Alam '124 teaches all of the subject matter of these rejected claims as noted at pages 2-5 of the outstanding Action with regard to exemplary independent apparatus claim 12. For example, there is no reasonable teaching or suggestion in this reference corresponding to the claimed "adding unit," the claimed "storage unit," and the claimed "judging unit" that encompasses the claimed functions that these elements must perform. It is noted that similar limitations appear in independent apparatus claims 13 and 24 as to these improperly interpreted claim 12 limitations, and that the subject matter of independent method claims 26 and 27 is also similar and also improperly interpreted in the outstanding Action.

Turning first to the claimed "adding unit," this unit is claimed to add "an imaging processing command **to the converted image data only when permitted to do so by a judging unit**" (emphasis added). The outstanding Action is clearly in error in suggesting that Alam '124 somehow teaches the addition of "an image processing command **to the converted image data only when permitted to do so by a judging unit**" (emphasis added) based upon the teaching at col. 20, lines 24-32.

To whatever extent that col. 20, lines 24-32, of Alam '124 teaches converting an input format to an intermediate format document **prior to conversion to the final output format document** (that is being interpreted to be the claimed converted image data in the at below-noted page 3 of the outstanding Action), there is no teaching of adding the "tag" disclosed by Alam '124 to the **final output format document** at col. 7, lines 24-32, or elsewhere.

Therefore, the position in the outstanding Action that the recital of "an image processing command" of the present invention can be reasonably interpreted as corresponding to a "tag" of Alam '124 is without merit. In this regard, "the image processing command" of the present

invention is added to the image data of which a format is converted. On the other hand, the "tag" of Alam '124 has already been included in a document in an input format before conversion as described in column 7, lines 15-16, and as noted above. Therefore, there is clearly a difference between Alam '124 and the present invention that has not been properly analyzed and treated by the outstanding Action.

Besides this clearly erroneous interpretation that the claimed recital of "an image processing command" of the present invention can be reasonably interpreted as corresponding to a "tag" of Alam '124, the outstanding Action erroneously suggests that the "storage unit" of exemplary claim 12 (with similar subject matter in the other independent claims 13, 24, 26, and 27) can be equated to the "hard drive shown in fig. 2" with apparent reliance on illustrated "fixed storage 155." To whatever extent that "the hard drive" is disclosed by Alam '124 to store plural file formats, such as PDS, RTF, etc., Alam '124 does not disclose that "information which shows whether addition of an image processing command to a converted image data is permitted" is stored in this hard drive. The outstanding Action attempts to correct this deficiency by noting that Alam '124 teaches that "if the input document is not in a supported format, process ends. If the input document is in a supported format, the input document is converted into an intermediate format document." This observation does not correct for the fact that the "hard drive shown in fig. 2" as fixed storage 155 of Alam '124 is not taught or suggested to store the claimed information regarding whether or not a file format permits (prohibits) addition of a processing command to the converted image data.

In this regard, even if the input document is not in a supported format and cannot be converted, this teaches nothing as to storing the required information as to "whether or not said plural file formats permit addition of the image processing command to the converted image data" in the hard drive shown in fig. 2 as fixed storage 155. The PTO reviewing court has held that such conclusory findings that omit analysis as to all claim limitations are improper. *See Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997).

Furthermore, claim 12 recites "an adding unit that adds an imaging processing command to the converted image data **only when permitted to do so by a judging unit**" (emphasis added). This is not all that is recited as to the "judging unit." In this regard, the "judging unit" of exemplary claim 12 (with similar subject matter in the other independent claims 13, 24, 26, and

27) is required to judge "whether or not the file **format of the converted image data** has said information in said storage unit that permits addition of the image processing command to the converted image data" (emphasis added). It is only after this judgment that the "judging unit" of exemplary claim 12 (with similar subject matter in the other independent claims 13, 24, 26, and 27) will **permit** the "addition by said adding unit of the image processing command to the converted image data only when said judging unit judges that said information in said storage unit permits addition of the image processing command to the converted image data."

The outstanding Action attempts to gloss over these claim requirements as to the "judging unit" cooperation with the contents of the "storage unit" in terms of the **file format of the converted image data** having to have "said information" that "permits addition of the image processing command to the converted image data." In this last respect, the Examiner argues that "a portion of the computer system that determines if the input documents is in a supported format" in Alam '124 can be said to correspond to the claimed "judging unit" of the present invention recited by independent claims 12, 13, 24, 26, and 27. Moreover, the Examiner indicates that a description in Alam '124 that "when the input document is in a supported format, adding tags into the input documents such as converting to an intermediate format and an output format" corresponds to a description of the present invention that "addition by said adding unit of the image processing command to the converted image data is permitted only when the file format of the converted image processing command to the converted image data." However, in Alam '124 it is a completely different "conversion/non-conversion" to the intermediate format that is not reasonably interpreted to be the permission/prohibition of addition of an image processing command as in the present invention of independent claims 12, 13, 24, 26, and 27.

In particular, page 3 of the outstanding Action suggests that the Fig. 25 step 2508 of determining if the input document format is a supported format (as noted at col. 20, lines 23-25) is equivalent to the initially noted "judging unit" operation. However, simply determining if an input format is supported has nothing to do with the required judging of "whether or not the file **format of the converted image data** has said information in said storage unit that permits addition of the image processing command to the converted image data" (emphasis added). The error in the Examiner's interpretation of the Fig. 25 step 2508 (that simply determines if the input document is in a supported format) being the claimed "judging unit," is that step 2508 is

clearly performed based upon the noted criteria that the **input format** is one that can be converted.

Similarly, the "judging unit" of exemplary claim 12 (with similar subject matter in the other independent claims 13, 24, 26, and 27) is recited as permitting "addition by said adding unit of the image processing command to the converted image data **only when said judging unit judges that said information in said storage unit permits addition of the image processing command to the converted image data**" (emphasis added). This is a clearly different operation from the step 2508 operation that simply determines if the input document is in a supported format. It is by now well established that every positively recited limitation in a claim must be given patentable weight. *See In re Wilder*, 429 F.2d 447, 450, 166 USPQ 545, 548, (CCPA 1970).

In view of the above, independent claims 12, 13, 24, 26, and 27 are respectfully submitted to clearly patentably distinguish over Alam '124, and the withdrawal of the rejection of independent claims 12, 13, 24, 26, and 27 under 35 U.S.C. § 102(b) is respectfully requested.

Furthermore, as claims 14-23 depend directly from independent claim 13 and as claim 25 depends directly from independent claim 24, these dependent claims are respectfully submitted to be improperly rejected as being anticipated by Alam '124 for at least the same reason as noted above as to respective parent independent claims 13 and 24. Accordingly, the withdrawal of the improper rejection of dependent claims 14-23 and 25 under 35 U.S.C. § 102(b) is respectfully requested.

CONCLUSION

The stated rejection of claims 12-27 is believed to have been overcome for the reasons set forth above. It is further believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Jr., Registration No. 40,440 at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

By_____

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